



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/021,043  | 12/19/2001  | Hideyuki Matsushima  | 05711.0136          | 9496             |
| 7590  | 01/26/2005  |                      | EXAMINER            |                  |
| Finnegan, Henderson, Farabow,<br>Garrett & Dunner, L.L.P.<br>1300 I Street, N.W.<br>Washington, DC 20005-3315 |             |                      | BAHTA, ABRAHAM      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1775                |                  |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/021,043 | <b>Applicant(s)</b><br>MATSUSHIMA ET AL. |  |
|                              | <b>Examiner</b><br>Abraham Bahta     | <b>Art Unit</b><br>1775                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

Claims 7-12 are pending in this application. Claims 1-6 have been canceled.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuBois (USP 4,96,322).

DuBois teaches a transparent cylindrical or tubular sheath wherein a reflective material is inserted into the tubular sheath. See col. 3, lines 13-51 and col. 4 lines 13-35. The sheath comprises a spacer so that the reflective material will not have a tendency to bind against the sheath inner surface. See col. 3, lines 16-27. The reflective material may be a rectangular piece of foil. See col. 2, lines 62-65. The reflective material may comprises a fixing portion such as radial projections for facilitating the passage of the of the support tube with attached foil, into the transparent tubular sheath. See col. 3, lines 19-28.

DuBois does not require a transparent cylinder made of soft synthetic resin; however, DuBois teaches the sheath is a plastic material (see col. 3, lines 35-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the transparent tubular sheath from a soft plastic (synthetic resin), since it has been held to be within the general skill of a worker in the art to select a

Art Unit: 1775

known material on the basis of its suitability regarding its expressly intended function.

Absent a showing of unexpected results, the term "soft" is not seen to provide patentable distinction over the reference.

Regarding claim 8, the reference teaches a spacer is provided so that the foil does not bind against the sheath inner surface as the sheath and support tube move axially relative to each other. See col. 3, lines 23-28. Thus, since DuBois reflective material does not bind against the sheath inner surface, there is implicitly an air layer between the reflective material and the inner surface of the sheath.

With respect to claim 9, the reference teaches the reflective material is rectangular piece of foil having a reflective outer surface.

Concerning claim 10, the reference teaches a fixing portion or spacer such as radial projections may be employed to serve for facilitating the passage of the support tube with attached foil into the transparent tubular sheath.

### ***Claim Rejections - 35 USC § 103***

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuBois (USP 4,96,322) in view of Billingsley et al (USP 6,110,558).

As discussed above, applicants claimed invention is taught by DuBois except DuBois does not require an attachment means on the outer surface of the sheath member; however, Billingsley teaches a reflective article having a retro reflective material wherein the article may be attached to shirts, sweaters, jackets, gloves, belts, hats, bags. The reference teaches the reflective article may be secured mechanically or

Art Unit: 1775

by use of an adhesive to a substrate such as a fabric or article of clothing. See col. 4, lines 3-6 and col. 7, line 30 - col. 8, line 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include an attachment means to the reflective article of DuBois as taught by Billingsley in order to attaché the reflective material to a desired object or substrate.

Regarding claim 12, DuBois does not require a retro reflective material; however, Billingsley teaches a reflective article having a retro reflective material. See col. 4, See col. 3-6.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include a retro reflective layer to the reflective material of DuBois in order to return a substantial portion of incident light in the direction from which the light originated as suggested by the reference. See col. 1, lines 17-19.

### ***Response to Applicant's Remarks/Arguments***

The applicant argues the reference to DuBois fails to disclose a cylindrical ornament body comprising a soft transparent cylindrical main body made of synthetic resin. It is the position of the Examiner that the cylindrical sheath of DuBois is made from a plastic material and that it is within the judgment of a skilled artisan to select a suitable material, including a soft synthetic material for the transparent cylindrical body depending on the intended use of the product; for example, soft synthetic material may be selected if the device is intended to be attached to garments such as clothing, hats or accessories such as bags, belts and if the device is intended to stand on a surface

Art Unit: 1775

the device may be made from durable or rigid plastic so that the device may be stable when placed on the surface. Further, one of ordinary skill in the art may select the material for the cylindrical body so that the weight of the device may be minimized. Since there is nothing to qualify the term "soft", it is not seen to provide a patentable distinction.

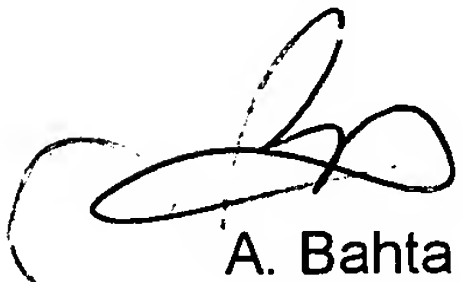
The applicant argues Billingsley '58 does not disclose, "a cylindrical ornament body comprising a soft transparent cylindrical main body made of synthetic resin. Billingsley is cited to show that an attachment device may be included with a reflective material in order to attach the reflective material to a desired object or substrate. Further, Billingsley is cited to show a retro-reflective material may be employed with a reflective material in order to return a portion of incident light in the direction from which the light originated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abraham Bahta whose telephone number is (571) 272-1352. The examiner can normally be reached on Monday - Friday; 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1775

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta  
01/21/05



DEBORAH JONES  
SUPERVISORY PATENT EXAMINER